

Application No. 09/844,083
Applicant: Oliver Nickel
Amendment in Response to Office Action dated December 11, 2003

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1-20 are pending. An amendment has been made to claim 11 in response to the objections and the rejections under 35 U.S.C. 112, second paragraph, starting at page 2 of the Office Action. Amendments have been made to claim 9 to cancel reference characters. Amendments have been made to the specification in response to the Examiner's objections, to cancel references to the claims, and to incorporate the subject matter of the originally filed claims into the specification. A mark-up showing the changes that have been made to these claims using strikethrough and underlining is presented above. It is believed that no new matter has been added.

At the outset, Applicant wishes to point out an Information Disclosure Statement will be filed citing co-pending application no. 09/431,849 in accordance with the Examiner's request at paragraph 4 of the Office Action.

Objection to the specification

The Examiner objected to the specification for not providing antecedent basis for "a line tape" in claim 11. In response, Applicant has amended the specification to provide antecedent basis, which is consistent with the original disclosure.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-20 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner found the term "composition" indefinite. In response, Applicant would remind the Examiner that claims are not to be read in a vacuum, but in light of the specification to which they are attached. See MPEP §2111.01; See also *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Applicant disagrees with the Examiner that a composition cannot be applied to a backing. The term "composition" is broad enough to include any chemical substance, and therefore, it is not understood why, for example, a liquid composition cannot be applied to a backing even if forms a layer thereon thereafter.

The Examiner found the terms "masking material" and "masking sheet" vague and indefinite. In response, a person skilled in the art would understand the meaning of the terms when read in light of the specification and Figures 1-3. The specification at page 5, lines 14-24 describes one embodiment of the interrelationship between the masking sheet (6) and the masking material (5).

The Examiner found the term "capable of" indefinite. In response, Applicant submits a structure and elements thereof can be defined in terms of the interrelationship of the elements or the characteristics the elements must possess. See *In re Venezia*, 189 USPQ 149 (CCPA 1976). In the present application, the instant claims require the masking material to have the characteristics of being able to adhere to and to absorb paint, while at the same time being

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"laminated in an edge region of the pressure-sensitive adhesive composition" and covered by the masking sheet. See instant claim 1. Because the masking material can be defined by its structural relationship, the claims are definite.

The Examiner found claim 11 indefinite. In response, Applicant points out that claim 11 has been amended to recite "a fine line tape".

For the record, Applicant emphasizes that although the claims were amended to overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicant did not narrow the claims in any material respect. Therefore, Applicant submits that the amended claims are entitled to the full range of equivalents.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Obviousness-type Double Patenting Rejections

Claims 1-20 are rejected under obviousness-type double patenting in view of co-pending application no. 09/431,849. Claims 1-3, 5-7, 10, 13-15, 17 and 19-20 are rejected under obviousness-type double patenting in view of co-pending application no. 09/844,084. In

Application No. 09/844,083
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response, terminal disclaimers over co-pending application no. 09/431,849 and co-pending application no. 09/844,084 are submitted herewith, as well as an associate power of attorney.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.


Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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Enclosure: Terminal Disclaimers over co-pending application nos. 09/431,849 and
09/844,084.

CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the two (2) terminal disclaimers are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, P.O. Box 1450, Alexandria, VA. 22313-1450, on the date indicated below:

Date: 11 March 2004

By 
David D. Kim